

Application № 10/810,186
Reply to Office Action of 05/19/2008

REMARKS / ARGUMENTS

The present application includes pending claims 1-36, all of which have been rejected. Claims 1 and 10-36 have been amended. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 13-24 have been rejected under 35 USC 101 as allegedly being directed to non-statutory subject matter. Claims 1-2, 10-12, 25-26, and 34-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,542,119 ("Grube"). Claims 3-9 and 27-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grube in view of US Patent No. 5,465,410 ("Hiben").

The Applicant respectfully traverses these rejections at least based on the following remarks.

I. Claim Rejections under 35 USC § 101

Claims 13-24 were rejected under 35 U.S.C.101 because the claimed invention is allegedly directed to non-statutory subject matter. The Examiner states the following in page 2 of the Office Action:

Claims 13-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13-24 fails to fall within a statutory category of invention. They are directed to the computer program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture

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structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It's also clearly not directed to a composition of matter. Therefore it is non-statutory under 35 USC 101.

The Applicant respectfully disagrees. The Examiner is referred to the following citation from the MPEP:

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, **“functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component.** (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) **“Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.**

See Manual of Patent Examining Procedure, 8th Ed., Rev. 5 (MPEP), Chapter 2106.01. The Applicant points out that the descriptive material in the preamble of claim 13 is not related to “music, literary works, and a compilation or mere arrangement of data.” Instead, the Applicant submits that the descriptive material in the preamble of claim 13 is related to “computer programs which impart functionality when employed as a computer component.” In other words, the material in the preamble of claim 13 is “functional descriptive material.” The Examiner is also referred to the following MPEP citation for support:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d

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1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

See *id.* The Applicant, therefore, submits that the material in the preamble of claim 13 is functional descriptive material, which is also statutory, as per the above MPEP guidelines, since it is recorded on a computer-readable medium. The Applicant submits that claims 13-24 are directed to statutory subject matter, and that the rejection of claims 13-24 under 35 USC § 101 should be withdrawn.

REJECTION UNDER 35 U.S.C. § 102

II. Grube Does Not Anticipate Claims 1-2, 10-12, 25-26, and 34-36

The Applicant turns to the rejection of claims 1-2, 10-12, 25-26, and 34-36 under 35 U.S.C. 102(b) as being anticipated by Grube. With regard to the anticipation rejections under 102, MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

A. Rejection of Independent Claims 1, 13, and 25 under 35 U.S.C. § 102(b)

With regard to the rejection of independent claim 1 under 35 U.S.C. § 102(b), the Applicant submits that Grube does not disclose or suggest at least the

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limitation of “modifying the determined signal quality metric for each of the plurality of signal paths,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

Referring to Claim 1, Grube teaches a method for choosing at least one signal path, the method comprising:

Determining a signal quality metric for each of a plurality of signal paths (see col. 4, lines 43-49 and step 508 in fig. 5);

Modifying the determined signal quality metric for each of the plurality of signal paths (see col. 5, lines 44-49 noting that the process in fig. 6 follows the process in fig. 5); and

Selecting at least one signal path based on the at least one of the modified signal quality metric (see col. 5, lines 61-67 noting that the “highest quality signal” is the selected signal path).

See the Office Action at page 3. The Examiner relies for support on FIG. 5 of Grube (receive operation). More specifically, the Examiner relies on step 508, during which a signal quality metric is determined for a received signal. In reference to the “modifying the determined signal quality metric” recitation, the Examiner relies on col. 5, lines 44-49, which relate to Grube’s FIG. 6 (transmit operation). **Grube, at col. 5, lines 44-49, simply discloses that a temporal tracking of the quality level of the highest quality signals is maintained in memory as a modified transmit signal quality metric. In other words, what Grube refers to as a “modified transmit signal quality metric” is a measure of the quality level of the highest quality signal. What the Examiner equates to Applicant’s “signal quality metric”, which is determined in FIG. 5, is**

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obviously not the same as the “modified transmit signal quality metric”. In fact, Grube does not even disclose that “signal quality metric”, which is determined in FIG. 5, is modified in any way. Therefore, the Applicant maintains that Grube does not disclose or suggest at least the limitation of “modifying the determined signal quality metric for each of the plurality of signal paths,” as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 102(b), the Applicant submits that Grube does not disclose or suggest at least the limitation of “selecting at least one of said plurality of signal paths for receiving a signal, wherein said selecting is based on at least one of the modified signal quality metrics,” as recited by the Applicant in independent claim 1. The Examiner relies for support on col. 5, ll. 61-67 of Grube, which discloses that the transmitter transmits 614 the chosen same highest quality signal from the local transmitter associated with the call and on the same frequency and substantially in phase with the other involved simulcast transmitter sites. In this regard, col. 5, ll. 61-67 of Grube relates to signal transmitting and does not relate to selecting a signal path for receiving a signal. In addition, Grube, including col. 5, ll. 61-67, does not disclose that the selecting is based on at least one modified signal quality metric. Therefore, the Applicant maintains that Grube does not disclose or suggest at least the limitation of “selecting at least one of said plurality of signal paths for receiving a signal, wherein said selecting is based on at least one of the

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modified signal quality metrics," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Grube and is allowable. Independent claims 13 and 25 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 13 and 25 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2, 10-12, 26, and 34-36

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 25 under 35 U.S.C. § 102(b) as being anticipated by Grube has been overcome and request that the rejection be withdrawn. Additionally, claims 2, 10-12, 26, and 34-36 depend from independent claims 1 and 25, and are, consequently, also respectfully submitted to be allowable.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-2, 10-12, 25-26, and 34-36.

III. Rejection of Dependent Claims 3-9 and 27-33

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 13, and 25 under 35 U.S.C. § 102(b) as being anticipated by Grube has been overcome and request that the rejection be withdrawn.

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Additionally, since the additional cited reference (Hiben) does not overcome the deficiencies of Grube, claims 3-9 and 27-33 depend from independent claims 1 and 25, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3-9 and 27-33.

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-36 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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